

Serial No. 10/072,553

Page 2:

REMARKS

This response is intended as a full and complete response to the non-final Office Action mailed December 29, 2005. The Examiner noted that claims 1-14 and 19-25 are pending and stand rejected.

In view of the following discussion, the Applicant submits that none of the claims now pending in the application are obvious under the provisions of 35 U.S.C. §103. Therefore, Applicant believes that this application is now in condition for allowance.

It is to be understood that Applicant does not acquiesce to the Examiner's characterizations of the art of record or to Applicant's subject matter recited in the pending claims. Further, Applicant is not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant response.

REJECTIONS

35 U.S.C. §102

Claims 1-5 and 25

The Examiner has rejected claims 1-5 and 25 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application 2002/0010925A1 for Kikinis ("Kikinis").

According to MPEP §2131, to anticipate a claim under §102, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is

425039-1

Serial No. 10/072,553

Page 3:

not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Independent claim 1 recites (and independent claims 8, 19, and 23 recite similar relevant elements):

1. A method, comprising:
providing at least one program listing for browsing and for selecting a given program listing, the program listing presented on a personal digital assistant (PDA) through the use of a local electronic program guide (EPG) stored on the PDA;
receiving, by the PDA, a reminder marking for a program that is not currently being aired; and
sending, the reminder marking to a set top terminal (STT) that stores a remote EPG, during synchronization between the local EPG on the PDA and the remote EPG on the STT, the synchronization being performed only after it is determined that the PDA is in direct communication with the STT.

Kikinis fails to teach every element of claim 1. Kikinis fails to teach sending a reminder marking to the STT that stores a remote EPG during synchronization between the local EPG on the PDA and the remote EPG on the STT, as claimed. By contrast, Kikinis merely uses an input device 160 to interact with the video display 105 in the same way that a conventional remote control 120 does. (See Kikinis, Figure 1, page 2, paragraph [0030].) Kikinis displays the same EPG on the display device 158 of the computing device 150 that is displayed on video display 105, i.e., the television. There is no local EPG on the PDA and remote EPG on the STT, as claimed. (See Kikinis, Figure 1, page 2, paragraphs [0029]-[0034].) Instead, there is only one EPG that is merely displayed in two places. Thus, there is no need to do any synchronizing, as claimed. In the claimed invention, the reminder is recorded in the local EPG running on the PDA and synchronized with the remote EPG running on the STT when communication between the two is established.

As such, Applicants submit that independent claims 1, 8, 19, and 23 are not anticipated by Kikinis under 35 U.S.C. §102. Furthermore, claims 2-7, 9-14, 20-22, and 24-25 depend from independent claims 1, 8, 19, and 23, respectively, and further define or recite additional limitations thereof. As such and at least for the same reasons as discussed above, Applicants submit that these dependent claims are also not

Serial No. 10/072,553

Page 4:

anticipated and patentable over Kikinis under 35 U.S.C. §102. Therefore, Applicants respectfully request that the rejection be withdrawn.

35 U.S.C. §103

Claims 8, 9, 14, 19, 21, and 23

The Examiner has rejected claims 8, 9, 14, 19, 21 and 23 under 35 U.S.C. §103(a) as being unpatentable over Kikinis.

According to MPEP §2143, to establish a prima facie case of obviousness under §103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Kikinis fails to teach or suggest at least sending a reminder marking to the STT that stores a remote EPG during synchronization between the local EPG on the PDA and the remote EPG on the STT, as claimed. For at least the reasons given above, claims 8, 9, 14, 21, and 23 are patentable over Kikinis under §103. Therefore, Applicants respectfully request that the rejection be withdrawn.

Claims 6, 7, 10, 11, 20, 22, and 24

The Examiner has rejected claims 6, 7, 10, 11, 20, 22 and 24 under 35 U.S.C. §103(a) as being unpatentable over Kikinis in view of U.S. Publication 2002/0133821 for Shteyn ("Shteyn").

Kikinis fails to teach or suggest at least sending a reminder marking to the STT that stores a remote EPG during synchronization between the local EPG on the PDA and the remote EPG on the STT, as claimed. Because Shteyn fails to bridge the gap between Kikinis and the claimed invention, claims 6, 7, 10, 11, 20, 22 and 24 are

Serial No. 10/072,553

Page 5:

patentable over the combination of Kikinis and Shteyn under §103. Therefore, Applicants respectfully request that the rejection be withdrawn.

Claims 12 and 13

The Examiner has rejected claims 12 and 13 under 35 U.S.C. §103(a) as being unpatentable over Kikinis in view of U.S. Patent 5,699,107 to Lawler ("Lawler").

Kikinis fails to teach or suggest at least sending a reminder marking to the STT that stores a remote EPG during synchronization between the local EPG on the PDA and the remote EPG on the STT, as claimed. Because Lawler fails to bridge the gap between Kikinis and the claimed invention, claims 12 and 13 are patentable over the combination of Kikinis and Lawler under §103. Therefore, Applicants respectfully request that the rejection be withdrawn.

Serial No. 10/072,553

Page 6:

CONCLUSION

Thus, Applicant submits that none of the claims presently in the application are anticipated or obvious under the respective provisions of 35 U.S.C. §102 and §103. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: 3/29/06

E J Wall
Eamon J. Wall
Registration No. 39,414
Attorney for Applicant

PATTERSON & SHERIDAN, LLP
595 Shrewsbury Avenue, Suite 100
Shrewsbury, New Jersey 07702
Telephone: 732-530-9404
Facsimile: 732-530-9808